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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,932	12/14/2004	Yasuharu Seki	258218US6PCT	8643
22850 7590 07/18/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MCADAMS, BRAD	
			ART UNIT	PAPER NUMBER
			2152	
			NOTIFICATION DATE	DELIVERY MODE
			07/18/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/516,932	<b>Applicant(s)</b> SEKI ET AL.	
	<b>Examiner</b> ROBERT MCADAMS	<b>Art Unit</b> 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/17/2007, 01/03/2007, 08/10/2006, 12/14/2004</u> .          | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 10** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to **Claim 10**, "A program" is being claimed. However it is not embodied on a medium which would enable the functionality of the program to be realized. As such, Claim 10 is non-statutory and rejected under 35 U.S.C 101 as a computer program.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1 – 4 and 8-10** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,751,794 *McCaleb et al (McCaleb)*.
3. As to **Claims 1, 3 and 8-10**, *McCaleb* discloses a managing means for managing first functional generation information as functional information of software

stored in a memory (**Server 105 manages a Client Database 125 with current client software versions (first functional generation information). Paragraph bridging Column 3 and 4);**

obtaining means for obtaining second functional generation information as functional information of software registered in an information providing apparatus via a network on a basis of said first functional generation information (**Server 105 (information providing apparatus) contains a Part Database 120 containing software patches and updates (second functional generation information) to help keep the Client Systems 110 and 115 up to date via a Network 103, Figure 1. Paragraph bridging Column 3 and 4);**

comparing and determining means for comparing said first functional generation information and said second functional generation information with each other and determining newest functional generation information ;

information updating means for, when said comparing and determining means determines that said second functional generation information is newer than said first functional generation information, updating said first functional generation information to said second functional generation information (**Server 105 compares current and new software versions (first and second generation information) to determine the newest version and updates Client system 110 with most current version. Column 4, Lines 31-44).**

As to **Claim 2**, *McCaleb* further discloses a means for determining whether a predetermined time has passed on a basis of said first functional generation

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information, wherein when said passage determining means determines that said predetermined time has passed, said obtaining means obtains said functional generation information registered in said information providing apparatus via said network (**Update is performed on a periodic basis, such as every 24 hours.**

**Column 4, Lines 11-18).**

As to **Claim 4**, *McCaleb* further discloses wherein when said function determining means determines that said software does not have the function corresponding to said second functional generation information, said software updating means updates the software stored in said memory using the software corresponding to said second functional generation information (**Server 105 may not know the current software version so a self check is performed, updating the Client System 110 to the updated version. Column 4, Lines 19-44).**

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 5-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,751,794 *McCaleb et al (McCaleb)* in view of U.S. Patent No. 6,327,584 *Xian et al (Xian)*.

6. As to **Claim 5**, *McCaleb* discloses comparing said first functional generation information and said second functional generation information with each other and determining newest functional generation information as cited in Claim 1.

However, *McCaleb* does not expressly disclose comparing a third functional generation information from a medium.

*Xian* discloses a medium determining means for determining whether a recording medium is loaded; and reading means for reading third functional generation information as functional generation of software recorded on said recording medium when said medium determining means determines that said recording medium is loaded and said information updating means updates said first functional generation information to said newest functional generation information; and said software updating means updates the software stored in said memory using software corresponding to said newest functional generation information. **(Update information (third functional generation) is loaded from the CD-ROM (medium) and used to update the original file (first functional generation) Column 13, Lines 30-42);**

*McCaleb* and *Xian* are analogous art because they are from the same field of endeavor with respect to file version management.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to compare the first and second functional generation information as taught by *McCaleb* with the third functional generation information as taught by *Xian* to determine the newest functional generation information. The motivation would have been to

provide another medium for updating versions.

As to **Claim 6**, *McCaleb* in view of *Xian* teaches when said obtaining means does not obtain said second functional generation information via said network, said comparing and determining means compares said first functional generation information and said third functional generation information with each other, and determines said newest functional generation information (**Current revision installed on computer and the revision on the CD-ROM (first and third functional generation information) are compared and the newest revision (functional generation information) is saved to the computer. Column 13, Lines 30-42**). The motivation is the same as Claim 5.

As to **Claim 7**, *McCaleb* in view of *Xian* teaches when said comparing and determining process determines that said second functional generation information and said third functional generation information are identical with each other, said information updating means updates said first functional generation information to said third functional generation information; and said software updating means updates the software stored in said memory using software corresponding to said third functional generation information (**Revision from the network and the revision on the CD-ROM (second and third functional generation information) are compared and the newest revision (functional generation information) is saved to the computer. Column 13, Lines 30-42**). The motivation is the same as Claim 5.



### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 6:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RBM/  
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/Bunjob Jaroenchonwanit/  
Supervisory Patent Examiner, Art Unit 2152